

Appl. No. 10/660,866
Amendment dated March 5, 2005

PATENT

REMARKS/ARGUMENTS

This Amendment is responsive to the Office Action mailed on February 10, 2005.

Initially, it is noted that a Preliminary Amendment was filed February 14, 2005, after the mailing date of the Office Action. A Notice of Non-Compliant Amendment was mailed by the PTO on February 22, 2005 indicating that the claims did not have the proper status identifiers. Accordingly, a Response to Notice of Non-Compliant Amendment was filed today in the USPTO. This Amendment is specifically responsive to the Office Action mailed on February 10, 2005 and includes the new dependent claims added in the Preliminary Amendment filed on February 14, 2005.

Claims 9, 10, and 12-14 are rejected as being anticipated by Mahulikar et al. This rejection is traversed. However, to expedite the prosecution, the limitation in dependent claim 11 is added to independent claim 9. Accordingly, the rejection based on Mahulikar et al. is obviated.

Claims 11 and 15 are rejected as being obvious over Mahulikar et al. and Joshi (U.S. Patent No. 6,627,991).

This rejection is traversed. Pursuant to 35 U.S.C. § 103(c), Joshi cannot be used to render the pending claims obvious, since Joshi and the present application were owned by the same assignee at the time of filing. The American Inventors Protection Act of 1999 ("AIPA") amended 35 U.S.C. § 103(c) to add that subject matter that only qualifies as prior art under 35 U.S.C. § 102(e) and that was commonly owned, or subject to an obligation of assignment to the same person, at the time the invention was made cannot be applied in a rejection under 35 U.S.C. § 103(a). Specifically, § 103(c) now states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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According to the AIPA § 4807(b), §103(c) applies to any patent application filed on or after the date of enactment, November 29, 1999. See also MPEP 706.02(1)(2).

Here, the present application claims priority to 09/619,115, filed on July 19, 2000 (i.e., after November 29, 1999) so that the changes to § 103(c) made by the AIPA apply to this application. Joshi issued on September 30, 2003, which is after the effective filing date for the present application (July 19, 2000). Accordingly, if it is prior art at all, it is prior art under 35 U.S.C. § 102(e).

Joshi and the present application were also commonly owned or subject to assignment to the same person, Fairchild Semiconductor Corporation at the time that the invention of the present application was made. In this regard, the undersigned, an attorney of record states:

U.S. Patent Application No. 10/660,866 and U.S. Patent No. 6,627,991 were, at the time the invention of U.S. Patent Application No. 10/660,866 was made, owned by Fairchild Semiconductor Corporation or subject to an obligation of assignment to Fairchild Semiconductor Corporation.

Since Joshi cannot be used to render the claims obvious, withdrawal of the obviousness rejection based on Mahulikar et al. and Joshi is requested.

We also note that Mahulikar et al. and Joshi appear to be directed to different types of devices. Accordingly, we believe that any proposed combination of Mahulikar et al. and Joshi would have been based on improper hindsight in view of Applicants' disclosure.

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CONCLUSION

In view of the foregoing, Applicants request a favorable Action on the merits.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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